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Attorney Docket No. 394-137

3632
J. Chayford
7-18-02
7/Recons

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Craig Novak et al.

*
Art Unit 3632

Serial No.: 09/909,423 ✓

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Examiner: Sterling, Amy Jo

For: Decorative Gift Bag Balloon Holder

Filed: July 19, 2001

June 21, 2002

REPLY

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Hon. Commissioner of Patents
and Trademarks
Washington D.C. 20231

It is respectfully requested that the Examiner reconsider her rejections noted in the Office action mailed May 17, 2002.

The Examiner had rejected claims 1-3, 8, 9 and 14 under 35 U.S.C. §103(a) by noting the disclosure of The Fun Place from the internet and United States patent no. 5,441,348 to Valentino. It is, however, respectfully submitted that the references applied by the Examiner neither teach nor suggest the invention recited in the claims, and reconsideration is thus requested.

As noted in the specification, balloon holders have been known that are formed of a small gift bag that may have a weight placed in the bottom of the gift bag with decorative tissue paper placed loosely inside to cover the weight. Note the specification as filed, page 3, lines 4-10. The Fun Place reference describes a party centerpiece of a weighted balloon

bouquet having the weight tucked into a decorated gift bag, and then covered with shredded paper. The Fun Place reference teaches creating the balloon holder as a craft item. Balloon holders simulating a gift bag as described in the Fun Place reference are thus made individually and typically for a single use by the user at home.

Balloon holders such as those described in the Fun Place reference are not manufactured readily by automatic techniques, nor can they be shipped, stored or displayed in a retail environment satisfactorily. Balloon holders simulating a gift bag have not, therefore, been mass produced as commercial items.

To provide decorative balloon holders that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder, applicant has discovered that securing the decorative material to the core providing the weight to hold the balloons in place will enable a commercial item to be produced.

Claim 1 recites "decorative material" that is "secured" to the core. The Fun Place reference teaches "covering" the weight with shredded paper and does not describe or teach securing the shredded paper to any core as required in claim 1. The reference merely teaches covering the core with shredded paper. The Examiner indicates the Fun Place reference inherently teaches the shredded paper is secured to the core. How does the reference teach the shredded paper is secured to the core? Are the individual pieces of shredded paper glued to the core? Are the shreds of paper somehow intertwined or glued together and then the amalgamation glued to the core?

Neither the Examiner nor the Fun Place reference provide any motivation to secure the shreds of paper to the anchor. The Fun Place reference does not "inherently" teach securing the shreds of paper to the weight. If the Examiner persists in holding the Fun Place reference "inherently" teaches securing the shredded paper to the weight, it is requested she point out precisely what passages of the reference she is relying upon for such disclosure.

Claims 3, 9 and 14 each require the decorative material being formed from a length of decorative sheet material having its upper portion cut into a series of strips adapted to extend outwardly from the decorative bag and its lower portion secured around the periphery of the core. The Valentino patent teaches cut strips of paper, but does not suggest securing the cut strips of paper to the periphery of a weighted core as expressly required in these claims.

Claim 8 additionally requires an inner liner fitted within the decorative bag with the core being held to a specific location on the liner and the decorative material being also held to the liner. The applied references do not disclose such a liner, nor do they disclose the holding of the core and decorative material to such a liner as set forth in claim 8, and the claims depending therefrom.

The Examiner has also held the securing of decorative elements in order to hold them in their desired locations is an "obvious permutation" of a balloon holder. However, a patentable invention may well result from the combination of elements old in the art and used for their known purpose when the inventor discovers the source of a problem even when the solution to the problem is obvious once the source of the problem has been identified. *In re*

Sponnobile, 405 F.2d 578, 585, 160 U.S.P.Q. 237 (CCPA 1969).

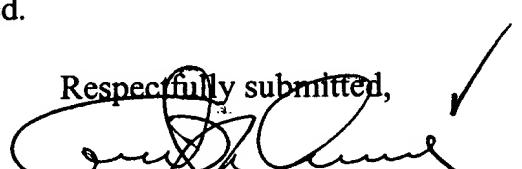
Although a prior art device may be capable of being modified to meet the claimed invention, there must be some motivation or suggestion from the art to make the modification, and applicant's disclosure may not be used in hindsight to justify the modification. *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432.

The Fun Place reference describes a craft item to be made at home, and does not pertain to solving any problems associated with a balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder. Applicant has discovered how to solve this problem to manufacture a commercial item, and the Examiner may not summarily dismiss the invention as obvious without some teaching of the solution to the problem solved by applicant.

Although the solution may appear simple in hindsight, such simplicity is no basis for rejection. *In re Horn, Horn, Horn and Horn*, 203 U.S.P.Q. 969 (CCPA 1979) and cases cited at page 971.

Reconsideration is thus requested.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents and Trademarks, Washington D.C. 20231, on June 21, 2002.

June 21, 2002


Gerard F. Dunne

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